

Application No.: 09/786,325

Docket No.: 21581-00255-US

**REMARKS**

Claims 19-54, 67-69 and 73-75 are now in the application.

Claims 67-69 and 73-75 are drawn to the elected invention. Claims 19-54 are drawn to the non-elected invention and may withdraw upon the allowance of the claims directed to the elected invention. Claim 67 has been rewritten to place it in independent form and not to limit its scope.

New claims 73-75 correspond to original claims 13-15, respectively.

Accordingly, the amendments to the claims and newly presented claims do not introduce any new matter or raise new issues.

Claims 66-69 were rejected under 35 U.S.C. 102(b) as being anticipated by or under 35 U.S.C. 103(a) as being obvious over European 0789036 to Kusakabe et al. Kusakabe et al. fails to anticipate or render obvious claims 67-69 and 73-75.

Independent claim 67 and new claim 73 of the present invention recite a composition comprising the vinyl polymer having a silanol group at one or more termini thereof and a silicon compound having two or more silicon atom-bound hydrolysable groups.

Contrary to this, Kusakabe et al. recites that a curing catalyst may be used to speed up the cross-linking on lines 17-21 of page 15. In particular, Kusakabe et al. suggests a curable composition comprising a vinyl polymer having a silanol group at one or more termini thereof and a curing catalyst, but does not recite a silicon compound having two or more silicon atom-bound hydrolysable groups. Thus, Kusakabe et al. fails to disclose or even remotely suggest a composition comprising a vinyl polymer having a silanol group at one or more termini thereof and a silicon compound having two or more silicon atom-bound hydrolysable groups. Therefore, amended claim 67, new claim 73 and their dependent claims 68-69 and 74-75 are novel and non-obvious.

Kusakabe fails to anticipate the present invention. In particular, anticipation requires the disclosure, in a prior art reference, of each and every recitation as set forth in the claims. See *Titanium Metals Corp. v. Banner*, 227 USPQ 773 (Fed. Cir. 1985), *Orthokinetics, Inc. v. Safety Travel Chairs, Inc.*, 1 USPQ2d 1081 (Fed. Cir. 1986), and *Akzo N.V. v. U.S. International Trade Commissioner*, 1 USPQ2d 1241 (Fed. Cir. 1986).

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There must be no difference between the claimed invention and reference disclosure for an anticipation rejection under 35 U.S.C. 102. See *Scripps Clinic and Research Foundation v. Genetech, Inc.*, 18 USPQ2d 1001 (CAFC 1991) and *Studiengesellschaft Kohle GmbH v. Dart Industries*, 220 USPQ 841 (CAFC 1984).

Also, the cited art lacks the necessary direction or incentive to those of ordinary skill in the art to render a rejection under 35 U.S.C. 103 sustainable. The cited art fails to provide the degree of predictability of success of achieving the properties attainable by the present invention needed to sustain a rejection under 35 USC 103. See *Diversitech Corp. v. Century Steps, Inc.* 7 USPQ2d 1315 (Fed. Cir. 1988), *In re Mercier*, 187 USPQ 774 (CC)A 1975) and *In re Naylor*, 152 USPQ 106 (CCPA 1966).

Moreover, the properties of the subject matter and improvements which are inherent in the claimed subject matter and disclosed in the specification are to be considered when evaluating the question of obviousness under 35 U.S.C. 103. See *Gillette Co. v. S.C. Johnson & Son, Inc.*, 16 USPQ2d. 1923 (Fed. Cir. 1990), *In re Antonie*, 195, USPQ 6 (CCPA 1977), *In re Estes*, 164 USPQ (CCPA 1970), and *In re Papesch*, 137 USPQ 43 (CCPA 1963).

No property can be ignored in determining patentability and comparing the claimed invention to the cited art. Along these lines, see *In re Papesch*, supra, *In re Burt et al.*, 148 USPQ 548 (CCPA 1966), *In re Ward*, 141 USPQ 227 (CCPA 1964), and *In re Cescon*, 177 USPQ 264 (CCPA 1973).

In view of the above, consideration and allowance are, therefore, respectfully solicited.

In the event the Examiner believes an interview might serve to advance the prosecution of this application in any way, the undersigned attorney is available at the telephone number noted below.

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The Director is hereby authorized to charge any fees, or credit any overpayment, associated with this communication, including extension fees to our Deposit Account No. 22-0185, under Order No. 21581-00255-US.

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Respectfully submitted,

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